

REMARKS

Item 4 of the current Office Action dated June 6, 2005 characterizes that action as final, in violation of accepted Patent Office standards, MPEP 706.07(a) (“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in **37 CFR 1.97(c)** with the fee set forth in **37 CFR 1.17(p)**), and the finality of the current Office Action cannot be sustained.

Item 4 of the current Office Action alleges that “Applicant’s amendment necessitated the new ground(s) of rejection;” however, the rejection of originally-filed claims 5 and 9 **was invalid** before this Office Action, and the rejection of originally-filed claims 5 and 9 continues to be invalid even under the new ground of rejection introduced by this Office Action.

In particular, the current Office Action **adds a new reference to convert the one-reference rejection into a two-reference rejection** of claims 5 and 9, but neither claim has ever been amended.

It was not the applicant’s amendment of claim 1 that necessitated the new ground of rejection of claims 5 and 9; instead, the persuasiveness of the applicant’s argument led to the newly-introduced ground of rejection for claims 5 and 9.

Reconsideration and withdrawal of the finality of the current Office Action are respectfully requested, to avoid the need for the applicants to take further measures within the Patent Office.

The Office Action dated June 6, 2005 has been reviewed and carefully considered. Claims 1-13 remain pending, of which the independent claims remain 1, 5 and 9. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1-13 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,966,652 to Coad et al. ("Coad").

Claim 1 recites:

A method for exchanging a message using a short message service (SMS) between a sending party and a receiving party over a call connection, the method comprising the steps of:
creating a text message by said sending party in a first portable digital phone;
creating a plurality of optional response messages associated with said text message;
and
forwarding said text message with said optional response messages to said receiving party over said call connection; and
receiving from the receiving party a return of one of said optional response messages.

Although the Coad call-back number is sent out as SMS payload to the telephone 102, the connection is then broken and the telephone 102 transmits the call-back number as cellular control information for setting up a new call connection. It is unclear to the applicant how this could properly be characterized as ". . . exchanging a message using a short message service (SMS) between a sending party and a receiving party over a call connection."

The last full sentence of page 2 in the Office Action acknowledges deficiencies in Coad, and cites to some Montgomery passages whose disclosure does not correspond with the explanation offered by the Office Action.

Montgomery relates to an attempted call connection that is not established because the telephone is busy or does not answer, whereas Coad relates to user interaction (col. 10, line 59).

Notably, in addition, although the Montgomery intended recipient can later access identification data captured and is given the option of a call back to the attempting caller, in “either case, the network receives the request and automatically initiates the appropriate call, from the subscriber’s telephone link” (col. 6, lines 47-49). Accordingly, a new call connection is required, as in Coad.

For at least the foregoing reasons, it is unclear to the applicant how the Office Action envisions Montgomery compensating for the shortcomings of Coad.

For at least the foregoing reason(s), the combination of references proposed by the Office Action fails to render obvious the present invention as recited in claim 1.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 5 recites, “. . . forwarding said selected optional response message back to said sending party via said SMS channel,” whereas Coad transmits the call-back number as cellular control information rather than “via said SMS channel.”

Montgomery does not relate to SMS, and cannot compensate for the shortcomings of Coad.

For at least this reason, Coad/Montgomery fails to render obvious the invention as recited in claim 5. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 9 recites:

creating a text message having a plurality of optional response messages associated to said text message in a first digital terminal of said sending party; . . . and forwarding said selected optional response message back to said sending party via said SMS channel.

Thus, claim 9 distinguishes patentably over the applied references for at least the same reasons set forth above with regard to claim 5.

In addition, Coad cellular control information is used by the cellular infrastructure for setting up a new call connection, but never arrives at “said sending party.” Accordingly, Coad fails to disclose or suggest, “. . . forwarding said selected optional response message back to said sending party.” The last full sentence of page 2 in the Office Action acknowledges deficiencies in Coad.

As mentioned above, Montgomery cannot make up for the deficiencies in Coad.

For at least the above reason(s), the combination proposed by the Office Action fails to render obvious the present invention as recited in claim 9.

Reconsideration and withdrawal of the rejection is respectfully requested.

As to the other rejected claims, each depends from a base claim and is deemed to distinguish patentably over Coad/Montgomery at least due to its dependency.

For all of the foregoing reasons, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to kindly telephone the undersigned at the telephone number listed below. If there are any fees due and owing, please charge Deposit Account No. 502-470.

Respectfully submitted,
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